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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,093	10/06/2003	Isao Ota	111398.01	4464
25944	7590	01/31/2006		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER MARCHESCHI, MICHAEL A	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/678,093

Applicant(s)

OTA ET AL.

Examiner

Michael A. Marcheschi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/980685.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) obvious over Kasai et al. (343) for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 1 is rejected under 35 U.S.C. 103(a) obvious over Ota et al. for the same reasons set forth in the previous office action which are incorporated herein by reference. The rejection of claim 3 has been withdrawn from the previous rejection based on Ota et al. since after further review the reference teaches a surface area outside the claimed range.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as obvious over either (1) Yoshida et al. (118), (2) Kido et al., or (3) Matsuzawa et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

Claim 1 is rejected under 35 U.S.C. 103(a) as obvious over either (1) Yoshida et al. (976) or (2) Homma et al.

The rejection based on Abbasi et al. is withdrawn in view of the translation of the priority document

Applicant's arguments filed 12/16/05 have been fully considered but they are not persuasive.

Before arguing the references, applicants states that comparative example 1, as defined in the instant specification, discloses benefits for the claimed ratio. This is not persuasive because the comparative example only is based on a cerium oxide content of 57% which is much lower

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than the claimed lower limit thus the example is not commensurate in scope with the claims and does not clearly show criticality the claimed ratio.

Applicants argue that Kasai et al. does not teach polishing glass hard disk platter. Although the limitation “glass hard disk platter” is not literally defined by this reference, the reference states that the composition is used to polish inorganic glass and quartz glass (column 9, lines 19-25) and it is the examiners position that this broadly reads on a “glass hard disk platter” since applicants do not show otherwise. Assuming arguendo, the reference clearly states that glass articles can be polished with the composition and one skilled in the art would have appreciated this to include any glass article, including the claimed one. Applicants also argue the claimed ratio as not being defined by this reference. Although not literally defined, it is the examiners position that since no other rare earth materials are defined as being present and/or no other rare earth is used in the process to make the cerium oxide, the amount of cerium oxide present is indirectly implied to be within the claimed range and applicants have not shown otherwise. In addition, applicants argue the comparative example defined in the instant specification but fail to establish any relationship between the commercially available cerium oxide of the comparative example and the reference cerium oxide. Is the cerium oxide of the comparative example the same as the reference cerium oxide? Finally, since no correlation is made, applicants have not compared the claimed invention with the reference teachings.

Applicants argue that Ota et al. does not teach polishing glass hard disk platter. Although the limitation “glass hard disk platter” is not literally defined by this reference, the reference states that the composition is used to polish quartz glass (column 11, lines 1-6). In view of this, the reference clearly states that glass materials can be polished with the composition and

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although the glass material defined is for optical fibers, it is the examiners position that one skilled in the art would have appreciated that other glass articles can be polished because the substitution of one glass article for another that is to be polished is clearly within the scope of the skilled artisan. In other words, the reference clearly implies that glass articles can be polished and although glass for optical fibers is only defined, it is the examiners position that one skilled in the art would have appreciated that other glass objects can be polished absent evidence to the contrary. Applicants also argue the claimed ratio as not being defined by this reference.

Although not literally defined, it is the examiners position that since no other rare earth materials are defined as being present and/or no other rare earth is used in the process to make the cerium oxide, the amount of cerium oxide present is indirectly implied to be within the claimed range and applicants have not shown otherwise. In addition, applicants argue the comparative example defined in the instant specification but fail to establish any relationship between the commercially available cerium oxide of the comparative example and the reference cerium oxide. Is the cerium oxide of the comparative example the same as the reference cerium oxide? Finally, since no correlation is made, applicants have not compared the claimed invention with the reference teachings.

Applicants argue that Yoshida et al. (118) does not teach polishing glass hard disk platter. Although the limitation "glass hard disk platter" is not literally defined by this reference, the reference states that the composition is used to polish magnetic disk glass substrates (column 6, line 42) and it is the examiners position that this broadly reads on a "glass hard disk platter" since applicants do not show otherwise. Assuming arguendo, the reference clearly states that glass articles can be polished with the composition and one skilled in the art would have

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appreciated this to include any glass article, including the claimed one. Applicants also argue the claimed ratio as not being defined by this reference. Although not literally defined, it is the examiners position that since no other rare earth materials are defined as being present and/or no other rare earth is used in the process to make the cerium oxide, the amount of cerium oxide present is indirectly implied to be within the claimed range and applicants have not shown otherwise. In addition, applicants argue the comparative example defined in the instant specification but fail to establish any relationship between the commercially available cerium oxide of the comparative example and the reference cerium oxide. Is the cerium oxide of the comparative example the same as the reference cerium oxide? In addition, since no correlation is made, applicants have not compared the claimed invention with the reference teachings. Finally, the reference states in column 2, line 31 that the abrasive (cerium oxide) is highly pure.

Applicants argue that Kido et al. does not teach polishing glass hard disk platter. Although the limitation “glass hard disk platter” is not literally defined by this reference, the reference states that the composition is used to polish a glass product and it is the examiners position that this broadly reads on a “glass hard disk platter” since applicants do not show otherwise. Assuming arguendo, although the reference defined types of glass products, it is the examiners position that it is not limited to this as is evident from the limitation “such as”. In view of this, the reference clearly states that glass products can be polished with the composition and although the claimed glass product is not literally defined, it is the examiners position that one skilled in the art would have appreciated that other glass products can be polished because the substitution of one glass article for another that is to be polished is clearly within the scope of the skilled artisan. In other words, the reference clearly implies that glass products can be

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polished, it is the examiners position that one skilled in the art would have appreciated that other glass objects can be polished absent evidence to the contrary. Applicants also argue the claimed ratio as not being defined by this reference. Although not literally defined, it is the examiners position that since no other rare earth materials are defined as being present and/or no other rare earth is used in the process to make the cerium oxide, the amount of cerium oxide present is indirectly implied to be within the claimed range and applicants have not shown otherwise. In addition, applicants argue the comparative example defined in the instant specification but fail to establish any relationship between the commercially available cerium oxide of the comparative example and the reference cerium oxide. Is the cerium oxide of the comparative example the same as the reference cerium oxide? In addition, since no correlation is made, applicants have not compared the claimed invention with the reference teachings. Finally, the reference states in column 4, line 33 that the abrasive (cerium oxide ) is highly pure. To rebut this purity teaching as not defining the claimed ratio, applicants state that this purity teaching does not teach the importance of the portion of cerium in the total rare earth elements of the abrasive composition. Irrespective of whether the importance is defined or not is immaterial because the abrasive used is highly pure and does not contain other elements, thus it is within the scope of applicants abrasive absent clear evidence to the contrary.

Applicants argue that Matsuzawa et al. does not teach polishing glass hard disk platter. Although the limitation “glass hard disk platter” is not literally defined by this reference, the reference states that the composition is used to polish glass substrates for magnetic discs (column 15, lines 37-38) and it is the examiners position that this broadly reads on a “glass hard disk platter” since applicants do not show otherwise. Assuming arguendo, the reference clearly states

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that glass articles can be polished with the composition and one skilled in the art would have appreciated this to include any glass article, including the claimed one. Applicants also argue the claimed ratio as not being defined by this reference. Although not literally defined, it is the examiners position that since no other rare earth materials are defined as being present and/or no other rare earth is used in the process to make the cerium oxide (i.e. the reference states that mosandrite can be used (column 4, line 64) which does not contain any other rare earth element), the amount of cerium oxide present is indirectly implied to be within the claimed range and applicants have not shown otherwise. In addition, applicants argue the comparative example defined in the instant specification but fail to establish any relationship between the commercially available cerium oxide of the comparative example and the reference cerium oxide. Is the cerium oxide of the comparative example the same as the reference cerium oxide? Finally, since no correlation is made, applicants have not compared the claimed invention with the reference teachings.

Applicants argue that Yoshida et al. (976) does not teach polishing glass hard disk platter. Although the limitation "glass hard disk platter" is not literally defined by this reference, the reference states that the composition is used to polish magnetic disk glass substrates (column 8, lines 39-40) and it is the examiners position that this broadly reads on a "glass hard disk platter" since applicants do not show otherwise. Assuming arguendo, the reference clearly states that glass articles can be polished with the composition and one skilled in the art would have appreciated this to include any glass article, including the claimed one. Applicants also argue the claimed ratio as not being defined by this reference. Although not literally defined, it is the examiners position that since no other rare earth materials are defined as being present and/or no



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other rare earth is used in the process to make the cerium oxide, the amount of cerium oxide present is indirectly implied to be within the claimed range and applicants have not shown otherwise. In addition, applicants argue the comparative example defined in the instant specification but fail to establish any relationship between the commercially available cerium oxide of the comparative example and the reference cerium oxide. Is the cerium oxide of the comparative example the same as the reference cerium oxide? In addition, since no correlation is made, applicants have not compared the claimed invention with the reference teachings. Finally, the reference states in column 3, line 24 that the abrasive (cerium oxide) is highly pure.

Applicants argue that Homma et al. does not teach polishing glass hard disk platter. Although the limitation “glass hard disk platter” is not literally defined by this reference, the reference states that the composition is used to polish optical glass elements (column 1, line 8) and it is the examiners position that this broadly reads on a “glass hard disk platter” since applicants do not show otherwise. Assuming arguendo, the reference clearly states that glass articles can be polished with the composition and one skilled in the art would have appreciated this to include any glass article, including the claimed one. Applicants also argue the claimed ratio as not being defined by this reference. Although not literally defined, it is the examiners position that since no other rare earth materials are defined as being present and/or no other rare earth is used in the process to make the cerium oxide, the amount of cerium oxide present is indirectly implied to be within the claimed range and applicants have not shown otherwise. In addition, applicants argue the comparative example defined in the instant specification but fail to establish any relationship between the commercially available cerium oxide of the comparative example and the reference cerium oxide. Is the cerium oxide of the comparative example the

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same as the reference cerium oxide? In addition, since no correlation is made, applicants have not compared the claimed invention with the reference teachings. Finally, the reference implies that the abrasive (cerium oxide) is highly pure.

In summary although the claimed ratio is not literally defined by the references, applicants have not show any comparative evidence directed to the reference abrasives that clearly establish the present of other rare earth elements.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

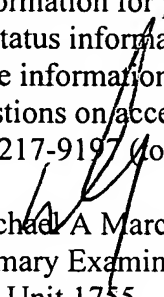
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-12331233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1/06  
MM



Michael A Marcheschi  
Primary Examiner  
Art Unit 1755